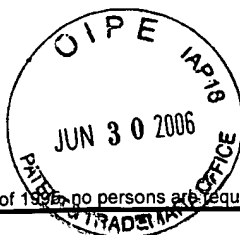


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

54071-39855

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on June 26, 2006

Signature _____

Typed or printed
name Joseph M. Rolnicki

Application Number

10/624,271

Filed

July 21, 2003

First Named Inventor

W. Kenneth Menke

Art Unit

2875

Examiner

Lee, Guiyoung

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 32,653☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____Joseph M. Rolnicki
SignatureJoseph M. Rolnicki
Typed or printed name314 (552) 6286
Telephone numberJune 26, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 37 CFR 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Docket No. 54071-39855



Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited in the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, PO Box 1450, Alexandria, Virginia, 22313-1450 on June 26, 2006.

Joseph M. Rolnicki
Joseph M. Rolnicki
Reg. No. 32,653

In re application of: Menke, W. Kenneth :

Serial No.: 10/624,271

Examiner: LEE, GUIYOUNG

Filed: July 21, 2003

Group Art Unit: 2875

For: LOW PROFILE EMERGENCY
VEHICLE LIGHT BAR

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Rejection of Claims 1-3, 6-9, 11, 13, and 15 as being obvious in view of the U.S. Patent of Eby, the U.S. patent of Lund, and the U.S. Patent of Krusemark No. 2,681,700.

Of the claims rejected, claims 1 and 9 are independent claims. These claims recite structural features of the invention that are not disclosed or suggested in the Eby, Lund, or Krusemark references. Furthermore, the references teach away from the claimed features.

The Eby, Lund, and Krusemark references all fail to suggest a mounting bracket having means for connecting the mounting bracket to the vehicle to hold the plurality of light assemblies in positions adjacent the window top edge and not above the top surface of the vehicle.

Claim 1 includes a recitation of the mounting bracket having means for connecting the mounting bracket to the light bar and to the vehicle to hold the support and the light assemblies on the support in positions extending across either the front or rear facing windows adjacent the top edge of the windows and not above the top surface of the vehicle. This feature of claim 1 is not disclosed or suggested by the lamp mount of the Eby reference. The Eby lamp mount is specifically designed to extend across the top surface of the vehicle. The hook bight portion 37 of the anchor member 36 is specifically designed to connect the channel bar 30 extending across and above the top surface of the vehicle as shown in Figure 2. There is no suggestion in the Eby reference of the mounting bracket recited in claim 1 that holds a support and light assemblies on the support adjacent the top edge of a vehicle window and not above the top surface of the vehicle.

The mounting bracket of the invention recited in claim 1 is also not disclosed or suggested in the Lund reference. The Lund reference makes no disclosure of such a mounting bracket. Instead, the Lund reference discloses a rigid visor 1 that is attached to the vehicle roof 30. The visor trailing edge 5 typically resides above the vehicle roof 60 (Lund column 2, lines 44-48). This attachment positioning is shown in Figure 1 of the reference where the visor 1, and in particular the trailing edge of the visor, is positioned on top of the vehicle roof. This teaches away from the subject matter of claim 1 which states that the mounting brackets position the support and the plurality of light assemblies adjacent the window top edge and not above the top surface of the vehicle.

The Krusemark reference also teaches away from the subject matter of claim 1. The Krusemark reference has no disclosure or suggestion of a support and a plurality of light assemblies that are positioned adjacent a top edge of a vehicle window but not above the top surface of the vehicle. The Krusemark reference specifically sets forth that the visor assembly shown in the reference is positioned over the windshield of the vehicle (col. 2, lines 12-13), and above the windshield of the vehicle (claims 1-5, line 2).

Furthermore, each of the Krusemark claims 1-5 describes the visor assembly as having a center support spaced above the center portion of the windshield. The Krusemark reference teaches positioning a visor assembly above a windshield, not adjacent a top edge of the windshield as recited in claim 1. Furthermore, the Krusemark reference provides no suggestion of not positioning a support and a plurality of light assemblies above the top surface of the vehicle as recited in claim 1.

There is nothing in any of the three references that suggests a support and a plurality of light assemblies positioned adjacent the top edge of a vehicle window, but not above the top surface of the vehicle. Reading this suggestion into the teachings of the three references can only result from hindsight of the present invention.

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

The ordinary skilled artisan, having no knowledge of the invention claimed, reading the disclosures of the three references would not be lead to the invention claimed. The rejection of the claims in view of the three references relies on hindsight of the invention, and therefore the rejection should be withdrawn and the claims allowed.

With regard to the rejection of claim 9 in view of the Eby, Lund, and Krusemark references, it is submitted that the claim is allowable for the same reasons discussed above with regard to claim 1. There is no motivation for combining these references. **Claim 9 specifically requires at least one mounting bracket having means for connecting the mounting bracket to the vehicle to hold the support extending "across" either of the vehicle windows.**

The Eby reference discloses a mounting bracket assembly for supporting an emergency light on the roof of an automobile. The references specifically sets forth that the main object of the invention is to provide a mounting bracket device adapted to be detachably connected to the roof of an automobile (Eby column 1, lines 6-8). The

reference further sets forth that a further object of the invention is to provide a mounting bracket assembly for supporting emergency lamps on the roof of an automobile (Eby column 1, lines 14-17). There is no suggestion of a support that holds lamps extending across the vehicle windows as required by claim 9.

The Lund reference, as explained earlier, discloses a visor 1 that is attached to a vehicle roof (Lund column 2, lines 44-45). The visor trailing edge resides above the vehicle roof (Lund column 2, lines 47-48). Thus, the Lund reference also fails to disclose or suggest a light support that is held extending across the vehicle window as recited in claim 9.

The Krusemark reference specifically sets forth that the visor assembly of the reference is positioned over the windshield of the vehicle (col. 2, lines 12-13), and above the windshield of the vehicle (claims 1-5, line 2). Each of the Krusemark claims 1-5 describes the visor assembly as having a center support adapted to be secured to the center part of the vehicle to lie spaced above the center portion of the windshield. The only teaching provided by the Krusemark reference is that of positioning a visor assembly above the windshield of a vehicle, not extending across the vehicle window as claimed.

The ordinary skilled artisan reviewing any of the three references relied on in rejecting claim 9 would not see a suggestion of a mounting bracket holding a support to a vehicle in a curved configuration of the support extending across the vehicle window as recited in claim 9. Because none of the applied references suggest the subject matter of the invention recited in claim 9, and actually teach away from that subject matter, the combination of references relied on in rejecting claim 9 is made in hindsight of the present invention, and therefore is improper. Claim 9 is therefore allowable over the prior art. Claims 11, 13, and 15 all depend from claim 9, and therefore are allowable over the prior art of record.

The disclosure of the U.S. Patent of Ohlenforst, et al. No. 4,488,141 does not overcome the shortcomings of the Eby, Lund, and Krusemark references.

Claims 4 and 5 depend from claim 1, and claim 10 depends from claim 9. The disclosure of the Ohlenforst reference does not overcome the shortcomings of the Eby, Lund, and Krusemark references discussed above, i.e. suggesting the subject matter of

the invention recited in independent claims 1 and 9. In view of the this shortcoming of all four references, claims 4, 5, and 10 are allowable over the prior art.

Respectfully submitted,

Thompson Coburn LLP

By: Joseph M. Rolnicki
Joseph M. Rolnicki
Reg. No. 32,653
One US Bank Plaza
St. Louis, MO 63101-1693
(314) 552-6286